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In re Application of KRAENZLER et al :  
U.S. Application No.: 10/564,668 :  
PCT Application No.: PCT/DE2004/002131 : DECISION  
Int. Filing Date: 24 September 2004 :  
Priority Date Claimed: 08 November 2003 :  
Attorney Docket No.: 3437 :  
For: TOOL HOLDING FIXTURE :

This is in response to applicant's "Renewed Request for Status Under 37 CFR 1.42" filed 26 April 2007, which is being treated under 37 CFR 1.42, 37 CFR 1.47(a), and 37 CFR 1.497(d).

**BACKGROUND**

On 24 September 2004, applicant filed international application PCT/DE2004/002131, which claimed priority of an earlier Germany application filed 08 November 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 02 June 2005. The thirty-month period for paying the basic national fee in the United States expired on 08 May 2006.

On 13 January 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a request for status under 37 CFR 1.42.

On 26 April 2007, this office mailed a decision dismissing the 13 January 2006 request for status.

On 26 April 2007, applicant filed the present renewed request for status along with petitions under 37 CFR 1.47(a) and 37 CFR 1.497(d).

**DISCUSSION**

**I. Request for Status Under 37 CFR 1.42**

The declaration states that joint inventor Markus Heckmann is deceased.

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The declaration filed 26 April 2007 fails to satisfy items (1), (3), and (4) above.

## II. Petition Under 37 CFR 1.47(a)

The petition states that Kirsten Heckmann, the legal representative of deceased inventor Markus Heckmann, refuses to sign the application papers.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, although applicant has submitted a declaration signed by the available inventors, each on his/her own behalf and on behalf of the nonsigning legal representative of the deceased inventor, the declaration is deficient for the reasons set forth in §I above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence

should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that Kirsten Heckmann refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Kirsten Heckmann for signature (see letter dated 29 August 2006). However, the petition fails to sufficiently illustrate that Kirsten Heckmann refuses to sign. The letter from Kirsten Heckmann dated 19 September 2005 merely states that she has disclaimed any rights to the invention, not that she refuses to sign the application papers. Lack of financial interest in a patent application does not relieve the inventor or his legal representative of the duty to sign. It is noted that if petitioner can establish that the letter to Kirsten Heckmann dated 29 August 2006 was either personally received by Ms. Heckman or that she resided at the delivery address at the time the correspondence was delivered, Ms. Heckman's failure to respond to the letter would constitute a constructive refusal to sign.

With regard to item (3) above, the requisite \$200.00 petition fee will be charged to Deposit Account No. 19-4675.

With regard to item (4) above, the petition states the last known address of the nonsigning legal representative.

### III. Petition Under 37 CFR 1.497(d)

The declaration lists two inventors, Christof Hoelzl and Johann Huber, who are not listed in the published international application.

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in 37 CFR 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see §3.73(b) of this chapter).

With regard to item (1) above, the requisite statements have been provided.

With regard to item (2) above, the requisite processing fee will be charged to Deposit Account No. 19-4675.

With regard to item (3) above, although the petition states that written consent of the assignee is attached, no such written consent appears in the application file.

**CONCLUSION**

For the reasons in §I above, the renewed request for status under 37 CFR 1.42 is DISMISSED without prejudice.

For the reasons in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

For the reasons in §III above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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